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| 10/690,852 | 10/21/2003 | Christopher Stevens | 18282US01 | 6937 |
| 23446 7590 08/22/2008 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661 | | | | |
| EXAMINER | | | | |
| LEIVA, FRANK M | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,852

Applicant(s)

STEVENS ET AL.

Examiner

FRANK M. LEIVA

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-15 and 18-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 7-15 and 18-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The examiner acknowledges cancellation of claims 6 and 17 and amendments to claims 1, 7, 12 and 18 in applicant's submission filed 05 March 2008.

Response to Arguments

2. Applicant's arguments filed 05 March 2008 have been fully considered but they are not persuasive. Applicant's sole argument relies on "should the player wish to continue playing the feature, a probability of success of the outcome is determined by the controller so that an average total prize awarded for the feature is approximately the same as the total prize the player would get if the player chose to leave the feature." However, the Applicant has carefully reviewed the documents cited in the Office Action concerning BBR4R, and can find no disclosure of this feature"; the examiner points that the use of Official Notice was used to cover the limitation above, and further adds that this would be no different than to say that the player may loose 3/4 or 1/2 of its original bet. The rules for the amount are determined by the payable selected in combination which the hit ratio. The applicant requested evidence for the Official Notice and thus given in the cited art of Olsen, Sharpless et al. and Gaidarev et al., in which they all concede that the payout are consistent with the PAR Sheets. Furthermore such mathematical calculations would be unpatentable under 35 U.S.C. §101(natural Law) and thus very little patent literature is found on the subject.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over IGT Beetle Bailey's Roll for Ranks Slot game, known hereafter as BBR4R, and further in view of Official Notice.

5. Regarding claims 1 and 12; BBR4R discloses :

A gaming machine having a display and a game controller arranged to control images of symbols displayed on the display, the game controller being arranged to play a game wherein at least one random event is caused to be displayed on the display means, and, if a predefined winning event occurs, the machine awards a prize, (page 2), whereas the pictures show a well known IGT class 3 gaming machine housing and all that comes with it.

The gaming machine further comprising a game feature in which at least a first outcome is guaranteed to be a successful outcome where a player is awarded a prize of a number of credits and where, upon being awarded at least one prize in the feature, a player is offered a choice and, if the choice results in a successful outcome, the player has the option of continuing with the feature but, if the choice results in an unsuccessful outcome, the feature ends and a portion, but not all, of a total prize accumulated up to termination of the feature is forfeited, (§§ 3 and 4), declare the bonus scheme and that it is well known to give or pay an instant amount to the bonus trigger event prior to entering the bonus round, and the consolation prize is portion of the total prize;

and wherein a probability of success of the outcome is determined by the controller so that an average total prize awarded for the feature if the player continues with the feature is approximately the same as the total prize the player would get if the player chose to leave the feature, the examiner takes the previously stated **Official Notice** to the fact that the amounts of payout and probabilities that the game is set for is guided by mathematical equations that are not patentable inventions, furthermore the amounts being, approximate or the

same or less than, the total prize the player would have gotten, is ruled by the percentage hold the game is set up for and would be considered a design choice amongst the limited choices available.

6. Regarding claims 2 and 13; BBR4R discloses in which the game feature is a second screen feature which is triggered when a predetermined trigger condition occurs in a base game, (Fig. 1[1]).

7. Regarding claims 3, 4, 14 and 15; BBR4R discloses in which a screen display of the game feature displays a paytable that indicates the number of credits that will be paid for various successful outcomes which occur during the playing of the feature, and in which the screen display of the second screen feature includes a prize meter which provides a cumulative total of the number of credits won due to successful outcomes which have occurred during the playing of the feature. (Fig. 1[2] and page 2 ¶3)

8. Regarding claim 10; BBR4R discloses including a selector to allow the player the opportunity of continuing with or leaving the feature, (page 2, ¶3).

9. Claims 7-9, 11 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over BBR4R as applied to claims 1 and 12 above, and further in view of Official Notice.

10. Regarding claims 7-8 and 18-19; BBR4R discloses: should the player wish to continue playing the feature, a probability of success of the outcome is determined by the controller so that an average total prize awarded for the feature is approximately the same as the total prize the player would get if the player chose to leave the feature, or should the player desire to continue with the feature, the controller determines the prize for a subsequent stage of the feature in the same way as for any previous stage of the feature by making a weighted random selection to determine the size of a prize associated with that stage, or in which a probability of success of the subsequent stage is dependent upon both the size of the prize for a successful outcome in the subsequent stage as determined by the controller and the size of a total prize that has so far been accumulated, (Page 1 and 2), The examiner takes official notice that the choice to pay

more in one bonus and less in another is clearly a design choice and that the game would not be affected by these differences as admitted by applicant in the effort of claiming 3 different embodiments for the bonuses in claims 6, 7, and 8.

11. Regarding claims 9 and 20, examiner takes official notice that all games must have a calculated percentage sheet whereas the pay table and game expected win is calculated. These odd calculations are not novel but required for the implementation of any gaming device, and vary according to the game playing features. It would not only be obvious but necessary for one having ordinary skill in the art, at the time of the applicant's invention, to incorporate these paytables and calculations in the design and reporting of these machines. One would be motivated to do so to comply with gaming regulations. Please review documentation (Nevada Gaming Commission, Minimum Internal Controls Standards, and the University of Reno Class Slots 101), not supplied but cited references as support for official notice.

12. Regarding claims 11 and 21, BBR4R discloses the loss of winnings if the outcome is unsuccessful and leaving a consolation prize, but it fails to teach the amount of the consolation prize being half of the accumulated wins. As pointed out in the rejection of claims 9 and 20, the amount of the consolation prize would be a calculated design choice and the math would be inherent to follow. The examiner claims that it would be an obvious design choice to let the player keep some of the winnings as a consolation prize, so that the player would risk going for the bonus more often and lowering the game payback ratio in favor of the house.

13. Examiner's Note: Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed

invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FRANK M. LEIVA** whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

FML
08/19/2008